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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,061	06/18/2001	Izumi Takemoto	P66783US0	1762

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EXAMINER

BOYD, JENNIFER A

ART UNIT PAPER NUMBER

1771

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,061

Applicant(s)

TAKEMOTO, IZUMI

Examiner

Jennifer A. Boyd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 8-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 8-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/15/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Applicant's Amendments and Accompanying Remarks, filed June 15, 2005, have been entered and have been carefully considered. Claims 1, 8, 9, 10, 11, 13, 15, 17, 23 and 25 are amended and claims 1 and 8 – 26 are pending. In view of Applicant's amendment requiring all of the warp filaments, all of the weft filaments or all of the warp and weft filaments are made of noble gold alloy metal monofilaments and that the other of all of the filaments of warp or all of the filaments of the weft are made of ordinary yarn, the Examiner withdraws all previously set forth rejections as detailed in Office Action dated March 29, 2005. The Examiner withdraws the objection to claim 26 as detailed in the Office Action dated March 29, 2005. After another search was conducted, additional prior art has been found which renders in the invention as currently claimed unpatentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Morikawa et al. (JP 06002238A).

Morikawa is directed to a noble metallic woven fabric and noble metallic article using the same (Title).

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As to claims 13 and 17, Morikawa teaches a metallic woven fabric comprising noble metallic wire having a diameter from 20 – 100 microns (Abstract). Morikawa teaches the use of gold wire (page 1, [0001]). As shown in Figure 2, the entire woven fabric is comprised of noble metallic wires; the Examiner equates this to Applicant's "all of the filaments of the warp", "all of the filaments of the weft" and "all of the filaments of the warp and weft".

It should be noted that the Examiner has given no patentable weight to "an article of apparel" and "an article of garniture". Furthermore, it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 102/ 103

4. Claims 11 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morikawa et al. (JP 06002238A).

Morikawa is directed to a noble metallic woven fabric and noble metallic article using the same (Title).

As to claims 11 and 15, Morikawa teaches a metallic woven fabric comprising noble metallic wire having a diameter from 20 – 100 microns (Abstract). Morikawa teaches the use of gold wire (page 1, [0001]). As shown in Figure 2, the entire woven fabric is comprised of noble metallic wires; the Examiner equates this to Applicant's "all of the filaments of the warp", "all of the filaments of the weft" and "all of the filaments of the warp and weft".

It should be noted that the Examiner has given no patentable weight to "an article of

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apparel” and “an article of garniture”. Furthermore, it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

As to claims 11 and 15, although Morikawa does not explicitly teach that the claimed monofilament tensile strength is 0.12 to 6.5 N as required by claims 11 and 15, it is reasonable to presume that monofilament tensile strength is 0.12 to 6.5N as required by claims 11 and 15 is inherent to Morikawa. Support for said presumption is found in the use of like materials (i.e. a woven fabric where all the warp and weft filaments are gold alloy metal monofilament having a diameter between 20 – 100 microns) which would result in the claimed property. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property would obviously have been present once the Morikawa product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

Claim Rejections - 35 USC § 103

5. Claims 1, 2, 8, 12, 14, 16, 18 and 23 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa et al. (JP 06002238A) in view of Ogasa (US 6,077,366).

Morikawa is directed to a noble metallic woven fabric and noble metallic article using the same (Title).

As to claims 1, 8 and 23 - 24, Morikawa teaches a metallic woven fabric comprising noble metallic wire having a diameter from 20 – 100 microns (Abstract). Morikawa teaches the use of gold wire (page 1, [0001]). As shown in Figure 2, the entire woven fabric is comprised of

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noble metallic wires; the Examiner equates this to Applicant's "all of the filaments of the warp", "all of the filaments of the weft" and "all of the filaments of the warp and weft".

As to claims 1, 8, 12, 14, 16 and 18, Morikawa fails to teach the composition of the gold alloy as containing at least 99.7% gold and a trace of an element chosen from the group consisting of gadolinium and calcium.

Ogasa is directed to a process for producing high-purity hard gold alloys (Title). Ogasa notes that the high-purity hardened alloy may be used in products such as medical parts (column 4, lines 45 – 47). Ogasa teaches a high-purity gold comprising a gold content of at least 99.7% or more by weight and containing 50 ppm or more of Gd (gadolinium) (column 2, lines 30 – 60). The Examiner equates containing 50 ppm or more of Gd to having a "trace of an element". Ogasa notes that the high-purity gold that has improved hardness, tensile strength and heat resistance (column 2, lines 55 - 60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the woven metal mesh of Morikawa comprising the gold alloy of Ogasa motivated by the desire to create a material that has improved hardness, tensile strength and heat resistance which is highly suitable for gold jewelry.

As to claims 2 and 24, although Morikawa in view of Ogasa does not explicitly teach that the claimed monofilament elongation is 1.5% or more as required by claim 2 and tensile strength of 0.12 to 6.5 N as required by claim 24, it is reasonable to presume that the monofilament

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elongation is 1.5% or more as required by claim 2 and tensile strength of 0.12 to 6.5 N as required by claim 24 is inherent to Morikawa in view of Ogas. Support for said presumption is found in the use of like materials (i.e. a gold alloy wire woven fabric with a diameter of 20 – 100 microns), which would result in the claimed properties. The burden is upon the Applicant to prove otherwise.

As to claim 23, Morikawa in view of Ogas discloses the claimed invention except for that the warp and weft monofilaments are different from each other in diameter. It should be noted that the diameter of the warp filaments and the weft filaments are result effective variables. The wire diameter directly affects the ability to weave, the flexibility and the appearance of the fabric. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a fabric having warp and weft monofilaments having different diameters since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have been motivated to create a woven fabric having warp and weft monofilaments having different diameters in order to create a flexible and aesthetically pleasing fabric suitable for jewelry.

6. Claims 9 – 10, 19 – 22 and 25 - 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa et al. (JP 06002238A) in view of Altman et al. (US 5,156,022).

Morikawa is directed to a noble metallic woven fabric and noble metallic article using the same (Title).

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As to claims 9 – 10 and 25 - 26, Morikawa teaches a metallic woven fabric comprising noble metallic wire having a diameter from 20 – 100 microns (Abstract). Morikawa teaches the use of gold wire (page 1, [0001]). As shown in Figure 2, the entire woven fabric is comprised of noble metallic wires; the Examiner equates this to Applicant's "all of the filaments of the warp", "all of the filaments of the weft" and "all of the filaments of the warp and weft".

Morikawa teaches the claimed invention above but fails to teach that the other of all of the filaments of the warp or all of the filaments of the weft is made of ordinary yarn as required by claims 9 – 10 and 25. Morikawa fails to teach that the ordinary yarn is selected from the group consisting of silk and cotton as required by claims 19 and 21.

Altman is directed to embroidered lace bracelets (Title). Altman teaches bracelets have been worn by people for a long time for a number of reasons including adornment of the persons hands or limbs, identification of something with which the person is associated, as an indication of a person's status, etc. As such bracelets range from very inexpensive bracelets of cotton cloth to bracelets made of very valuable materials such as gold, silver, etc. which are very expensive (column 1, lines 10 – 25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate cotton as suggested by Altman into all of the warp or all of the weft as required by Applicant in the woven metallic fabric of Morikawa motivated by the desire to reduce cost of the fabric while maintaining an aesthetically pleasing appearance.

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As to claims 20, 22 and 25, Morikawa in view of Altman discloses the claimed invention except for that the warp and weft monofilaments are different from each other in diameter. It should be noted that the diameter of the warp filaments and the weft filaments are result effective variables. The wire diameter directly affects the ability to weave, the flexibility and the appearance of the fabric. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a fabric having warp and weft monofilaments having different diameters since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have been motivated to create a woven fabric having warp and weft monofilaments having different diameters in order to create a flexible and aesthetically pleasing fabric suitable for jewelry.

Response to Arguments

7. Applicant's arguments with respect to claims 1 – 2 and 8 – 26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer Boyd
August 29, 2005


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